

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/516,597

Confirmation No.: 8558

Applicant : Etienne Degand et al.

Filed : December 3, 2004

TC/AU : 3742

Examiner : Vinod D. Patel

Docket No. : 4004-063-30 NATL

For : Heatable Glazing Panel

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF**

Sir:

This paper is filed in response to the Notification of Non-Compliant Appeal Brief, dated October 10, 2008.

**Remarks** begin on page 2 of this paper.

**REMARKS**

This paper is filed in response to the Notification of Non-Compliant Appeal Brief, dated October 10, 2008.

At the outset, Appellant wishes to thank the Examiner for the telephonic interview on October 20, 2008. The interview was sought in an effort to avoid any further non-compliances. The interview was helpful to the Appellant in understanding the basis of each ground of non-compliance raised by the Examiner. Appellant is submitting an Interview Summary and an Amended Appeal Brief concurrently with this Response. The Amended Appeal Brief has been revised in accordance with the Examiner's requirements in order to advance the appeal to consideration on the merits. Below is Appellant's response to each ground of non-compliance and a summary of the changes made to the Appeal Brief:

**Summary of the Claimed Subject Matter**

In the Notification, the Examiner indicated that the Summary of Claimed Subject Matter section was non-compliant because "(a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawing, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v))."

During the telephone interview, the Examiner further explained that the Appeal Brief was not compliant because a summary was not provided for the dependent claims on appeal.

Appellant expressed its understanding of 37 CFR 41.37(c)(1)(v) to the Examiner, namely, that the only dependent claims that need to be addressed in the Summary of the Claimed Subject Matter section of the Appeal Brief are only those that include means plus function and step plus function language. The Examiner disagreed.

Appellant respectfully maintains that the plain language of 37 CFR 41.37(c)(1)(v) makes clear that only the independent claims and only those dependent claims that have means plus function and step plus function language must be presented in the Summary of the Claimed Subject Matter section of the Appeal Brief. None of the claims of the present application have means plus function or step plus function language. Therefore, Appellant respectfully submits that the Summary of the Claimed Subject Matter section of the originally submitted Appeal Brief – which included a discussion of independent claim 1, the sole independent claim pending in the application – was fully in compliance with the rules.

Nonetheless, Appellant does not wish to prolong the appeal process with formal matters. Therefore, Appellant has amended the Summary of Claimed Subject Matter section in an effort to advance the appeal. In particular, Appellant has adopted the Examiner's suggestion during the telephone interview to separately present each dependent claim on appeal in the Summary of Claimed Subject Matter section of the Appeal Brief. Thus, Appellant believes the Summary of Claimed Subject Matter section, as amended, to be in compliance with the rules and the Examiner's requirements.

Other Non-Compliances

The Examiner instructed Appellant to "Remove foot note # 3, all dependent claims must be argued separately." Appellant has reviewed the governing rules and respectfully submits that there does not appear to be any rule that requires each dependent claim on appeal to be argued separately. Further, the text of original footnote 3 reads as follows: "Should any additional basis for rejection be advanced, even if only the same documents are relied upon, Appellant should be afforded the opportunity to respond rather than requiring the claims to stand or fall together." Appellant is not sure how this reservation causes a problem with the Examiner's requirement that "all dependent claims must be argued separately." Therefore, Appellant believes the previously submitted Appeal Brief was in compliance with the rules.

Nonetheless, in an effort to advance the appeal and to avoid further notices of non-compliance, Appellant has amended the Appeal Brief by deleting footnote 3, as suggested by the Examiner, and all subsequent footnotes (4 and 7-10) that reference back to footnote 3. Appellant believes that the Amended Appeal Brief satisfactorily addresses the issues raised by the Examiner. Appellant also believes the reservations set forth in original footnote 3 still apply to this appeal, despite the removal of the express reservations from the Appeal Brief.

**CONCLUSION**

As set forth above, Appellant has amended its Appeal Brief in accordance with the Examiner's suggestions in an effort to avoid further notices of non-compliance and to move the case forward to a consideration on the merits. Appellant believes each basis of non-compliance has been satisfactorily addressed in the Amended Appeal Brief. If the Examiner believes that

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any portion of the Appeal Brief is still non-compliant, Appellant invites the Examiner to contact the undersigned to resolve the matter.

Respectfully submitted,

Date: October 21, 2008

/ Mark M. Zylka /

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